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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,836	07/25/2003	Gert Neumann	A-8656.roa	9255

7590 09/27/2005

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/626,836

Applicant(s)

NEUMANN ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 to 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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1. Claims 1 to 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

*Claim 1:*

In claim 1, as well as other claims, the phrase "can be" is somewhat indefinite because it is unclear if this is a limiting requirement or merely what "can be". The Examiner suggests replacing this with a more definite term or phrase such as "are". Thus the indefinite language "and can in particular be selected from the group" would read "and are selected from the group". This applies to other claims as well.

Also in claim 1, the phrase "selected from the group comprising" is indefinite. See M.P.E.P 2173.05(h), drawn to alternative limitations, specifically Markush groups.

Claim 1 contains various spelling errors such as "abovementioned" (which should be two words) and "alkinyl".

The definition of X is confusing in that it is unclear what the term "optionally" prior to "alkoxy groups" further defines. Also, it is unclear what is limited by the phrase "having from 5 to 20 carbon atoms". Finally, it is unclear what is modified by the phrase "whereby the abovementioned groups have one or more substitutes..." since many different groups are mentioned above.

Reference to "the monomer compounds" lacks antecedent basis.

In the second to the last line on page 13, the last formula is missing a left hand side parenthesis "(".

*Claims 2 to 13:*

Reference to "the antistatic coating" of claim 1 lacks antecedent basis since claim 1 is defined as an electrically conductive coating.

*Claim 13:*

The term "long chain" is rendered indefinite because the breadth of "long chain" is not defined.

*Claim 16:*

It is unclear what weight to give the phrase "having the characteristics of claim 1".

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2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 14 to 16 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 199 42 423, as interpreted by the English language equivalent Dreihöfer et al.

Dreihöfer et al. teach a coating composition for toner drums. The basis for this rejection relies on the fact that claim 14 requires “at least one of the compounds specified in claim 1” rather than the coating of claim 1. This means that the prior art need not contain an ether having an alkenyl group in the coating to meet this claim.

With this in mind, note that Dreihöfer et al. teach an antistatic coating prepared by hydrolytically condensing one of the compounds (I) and (II) in claim 1, followed by radiation curing. See column 3, line 33, column 4, line 44 and column 6, lines 37 to 57. Since it is unclear what “having the characteristics of claim 1” means, this can be interpreted as having electrically conductive characteristics. This is met by Dreihöfer et al., see the abstract.

The Examiner notes that a 102(e) rejection of Dreihöfer et al. has not been made since a 102(b) rejection takes precedence.

4. Claims 1 to 13 are neither taught nor suggested by the prior art. There simply is no teaching or motivation to add an ether having alkenyl groups to the composition in Dreihöfer et al. While column 5, lines 55 to 65, teaches the addition of ethers, preferably lower dialkyl ethers, as a solvent, there simply is no motivation to select an ether having alkenyl groups as the solvent. The Examiner was unable to find any indication that this is a common solvent or one that the skilled artisan would have been motivated to use in place of the lower dialkyl ethers taught by Dreihöfer et al. In addition the prior art provides no motivation to add such a compound to Dreihöfer et al. for any other reason.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).


6. Claims 14 to 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18 to 24 of U.S. Patent No. 6,500,552. Although the conflicting claims are not identical, they are not patentably distinct from each other because of reasons noted supra. See for instance that the process of claim 18 in '552 includes compounds found in instant claim 1, claim 20 is drawn to a precondensate and claim 18 teaches the layers required by instant claim 16.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore  
Primary Examiner  
Art Unit 1712

mgm  
9/21/05